

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Bradley S. Templeton
SERIAL NO.: 09/416,278
FILING DATE: October 14, 1999
TITLE: Method and Apparatus for Intermediation of Meetings and Calls
EXAMINER: Beth Van Doren
GROUP ART UNIT: 3623
ATTY. DKT. NO.: 5338.01 (SMC)

PRE-APPEAL BRIEF (REVISED)

A Pre-Appeal Brief was filed on May 26, 2008. Following that filing, the Applicant received an unexpected Advisory Action. The Applicant thanks the Examiner for the Advisory Action and entry of amendments, and submits this revised Pre-Appeal Brief addressing specific comments made in the Advisory Action.

This brief is directed to the rejection of Claims 88-89, 91, 97 and 98 under 35 U.S.C. 102(e) as being anticipated by Gisby et al. (US 6,044,146).

1) At issue in the rejection of Claims 88-89, 91, 97 and 98 is whether the Examiner has made a prima facie case for the rejection under 35 U.S.C. 102(e).

It is the position of the Applicant that the Examiner has failed to present a prima facie case for the rejection because the examiner has failed to point out a teaching of the claim limitations “*if the requester is unavailable, then waiting until a time the requestor becomes available*” within the prior art.

In rejecting Claim 88, the Examiner states:

The limitation “if the requester is unavailable, then waiting until a time the requestor becomes available” does not occur in methods where the requester is available, in the previous limitations. Therefore, since Gisby et al. teaches that the requester is available,

the limitation “if the requester is unavailable, then waiting until a time the requestor becomes available” is not required.

It appears that the Examiner is taking the position that because there are conditions under which a method step is not performed the Examiner is relieved of the requirement to show that step in the prior art.

The requirement that an Examiner point out a prior art teaching of every limitation in a claim is well established. See for example, MPEP § 2106.II.C which states “[w]hen evaluating the scope of a claim, every limitation in the claim must be considered,” (Diamond v. Diehr, emphasis in original) and MPEP § 2131 which states a “claim is anticipated only if each and every element as set forth in the claim is found.”

The Examiner does not cite any regulation, rule, statute or decision that would relieve her of the requirement to show a teaching of every claim element in the prior art. Specifically, the Examiner has not articulated or cited statutory support of any alternative standard for rejection under 102(e) other than those of MPEP § 2106.II.C. and MPEP § 2131 as quoted above. To the contrary, the Examiner’s position is in direct contradiction to well established case law.

In the Advisory Action of June 2, 2008 the Examiner quotes MPEP sec. 2111.04 which states “[c]laim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed...” The Examiner further states “the if language utilized in the claim suggest but does not require certain steps to be performed when the claims scope is analyzed.”

First, the Examiner appears to be confusing conditional language with optional language. Conditional language does not make a step optional as long as there is at least some condition within the invention in which the condition is satisfied and, therefore, the step *must* be performed. It is well established that conditional language limits the scope of a claim. See, for example, *Altiris, Inc. v. Symantec Corp.* 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1871 (Fed. Cir. 2003), wherein the court held that conditional language in the body of the claim indicated that a “transferring” step and an “executing step” should **necessarily** be performed prior to boot up. In

the same case at 1138 the court states “The only order mandated by the claim language is the conditional language in several of the steps, indicating that they **must** be performed after the “testing” step,” (emphasis added). Thus, the Fed. Cir. routinely gives conditional language the full weight of consideration due any other non-optional claim limitation.

Second, in the Advisor Action the Examiner states “[w]hen performing the process, only one of the ‘if’ statements can occur since it is not possible to satisfy that a requestor is both available and unavailable at the same time. Thus, when properly construing the claim scope, only one if statement is included in the subject matter that must be examined.” It is the position of the Applicant that this argument cannot be applied to claims 97 and 98 each of which include only one “if” statement *the limitations of which have not been pointed out by the Examiner in the prior art*. In regard to these claims, the Examiner has failed to meet even her own standard that “only one if statement is included in the subject matter that must be examined.”

Third, the Applicant has previously argued that the Examiner has failed to meet the requirements of a *prima facie* case for rejection. In response the Examiner argues that there are conditions in the prior art under which particular limitations will not occur. The Applicant respectfully points out that the Examiner’s arguments are off point. It is immaterial that under particular conditions a particular method step will not be performed in the prior art. What is material is that the condition does occur in the invention and whether the Examiner has presented a *prima facie* case for rejection. Specifically, the burden is on the Examiner to show teachings of every limitation in the prior art, NOT to show that limitations do not occur in the prior art as she has done.

Fourth, the Applicant points out that the claim covers not just one specific condition but several conditions. To anticipate the claim the prior art must teach all of the limitations as long as there is at least some condition under which each of the limitations serve to limit the scope of the claim. The fact that only one of the “if” statements occurs under a specific set of conditions does not mean that limitations following the “if” statement can be disregarded when there are other

conditions under which the other “if” statement will occur. Here we have a condition of a requestor not being available, this condition may occur in various embodiments of the invention. As such, the limitations subject to this condition do function to narrow (limit) the scope of the claim and they must be taught by the prior art for the prior art to anticipate the claim.

There is no basis that allows the Examiner to pick and choose which conditions under which the claim should be considered. The fact that there are some conditions under which a method step will occur in the invention means that the Examiner must find this step in the cited art or allow the claim.

Fifth, assuming for the sake of argument that the Examiner is correct in her position that when there is some condition that a step is not performed, then there is no need to show the limitations of that step in rejecting a claim. This position would make all conditional claim limitations irrelevant. By their very nature a claim that includes “if X then Y” suggests that there are some conditions under which X is false. If the Examiner’s position were correct, then any method step that included conditional language could be ignored by merely pointing out the case where the condition is false. This is clearly not the case as illustrated by *Altiris, Inc. v. Symantec Corp.* cited above and the Examiner’s position, therefore, cannot be correct.

Sixth, the fallacy of the Examiner’s position is also illustrated by claims 97 and 98. Claim 97 is an amended version of Claim 88 wherein the limitation “*if the requestor is available, then initiating the first real-time meeting*” is removed.

By definition this amendment would be a broadening of Claim 88 because a limitation is removed. Any teaching that anticipated the original version of Claim 88 should, therefore, also anticipate this claim. However, in claims 97 and 98 the Examiner’s basis for ignoring the last claim element has now been eliminated. Specifically, the condition that the requestor is available is no longer part of the claim. The Examiner must, therefore, consider the last claim element, which is not taught by the cited art. The result of this logic is that a broader claim is not anticipated by the cited art while a narrow claim is anticipated. Clearly, this cannot be the case.

The suggestion that the last claim element can be ignored in the original claim must, therefore, be false.

Seventh, the Examiners statement "since Gisby et al. teaches that the requester is available, the limitation 'if the requester is unavailable, then waiting until a time the requestor becomes available' is not required" appears to be an express admission that the limitations are NOT taught by the cited art. The Examiner is characterizing Gisby by pointing out that a step is not required in the prior art, e.g., it does not occur in the prior art. The Applicant respectfully points out that these arguments by the Examiner support allowability of these claims rather than their rejection.

The Applicant believes that all pending claims are allowable and respectfully requests that the Examiner issue a Notice of Allowance. Should the Examiner have questions, the Applicant's undersigned representative may be reached at the number provided below.

In addition, Applicant respectfully invites the Examiner to contact Applicant's representative if the Examiner believes it will help expedite furtherance of this application.

RESPECTFULLY SUBMITTED,
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